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10/585,107	06/14/2007	Mario Polegato Moretti	293045US0PCT	6058
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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.			EXAMINER	
1940 DUKE STREET			VO, HAI	
ALEXANDRIA, VA 22314			ART UNIT	PAPER NUMBER
			1787	
NOTIFICATION DATE	DELIVERY MODE			
04/09/2010	ELECTRONIC			

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/585,107	<b>Applicant(s)</b> POLEGATO MORETTI ET AL.
	<b>Examiner</b> Hai Vo	<b>Art Unit</b> 1787

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 10 March 2010.  
 2a) This action is FINAL.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 39-76 is/are pending in the application.  
 4a) Of the above claim(s) 57-60,71 and 73-76 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 39-56,61-70 and 72 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 30 June 2006 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date: \_\_\_\_\_  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

***Election/Restrictions***

1. Applicant's election with traverse of Group I, polysiloxane species, claims 39-56, 61-70 and 72 in the reply filed on March 10, 2010 is acknowledged. The traversal is on the grounds that the examiner has not provided any detailed analysis establishing that claim 39 is obvious over the prior art. This is not found persuasive because claim 39 is, in fact, anticipated or strongly suggested by Rechlicz et al. (US 5,032,450) (see rejections below). Applicants further contend that there will be no serious burden on the examiner if the claims of two inventions are examined together. That is not true because the search of Group I does not require a search in the same areas as a search for Group II. The inventions require a different field of search and different search queries. The article claims of Group I and the method claims of Group II are classified in two different classes, class 428 vs. class 427. The same token is applied to the species restrictions. Species (i) and (ii) require a different field of search and different search queries; and/or the prior art applicable to one species would not likely be applicable to another species (see US 5,032,450 to Rechlicz et al.).
2. Applicants are reminded of their right to request rejoinder of method claims with the product claims upon indication of the product claims as being allowable. The method claims must be commensurate with the allowed article claims, i.e. have been amended to recite all the features of the allowed article claims. See *In re Ochiai* 37 USPQ2d 1127.

***Claim Objections***

3. Claim 45 is objected to because of the following informalities: there appears to be a typo in the unit "pm". Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:  
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:  

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
6. Claims 39-55 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Lechhart et al. (US 2005/0172513). Lechhart teaches a breathable sole structure comprising an insole, an outsole and a functional membrane system wherein the functional membrane system includes a microporous hydrophilic membrane and a

microporous hydrophobic membrane (abstract and figure 2). The hydrophilic membrane has a thickness of 250 to 1200 microns, an average pore size in the range from 0.1 to 1 micron, and an average porosity of 60 to 70% (paragraph 14). The hydrophilic membrane is commercially available under the trade name DARAMIC. The hydrophobic membrane is commercially available under the trade name CELGARD. They are the same types of the membranes used by Applicants. Therefore, it is not seen that the materials constituted of the first layer and the second layer respectively could not be inherently present as like material has like property. This is in line with *In re Spada*, 15 USPQ 2d 1655 (1990) which holds that products of identical chemical composition can not have mutually exclusive properties. Lechhart anticipates or strongly suggests the claimed subject matter.

7. Claims 39-52, 56, 61-70, and 72 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Rechlicz et al. (US 5,032,450). Rechlicz teaches a coated article comprising a moisture vapor permeable coating of polysiloxane on one side of the sheet of microporous material (abstract). The microporous material is a matrix of polyolefin and siliceous filler, having interconnecting pores. The polyolefin is formed from a Ultrahigh molecular weight polyethylene (UHMWPE) which is commercially available under the trade name Himont 1900. Zachariades et al. (US 5,479,952) will be relied upon to show the state of fact, that is, the UHMWPE has an average molecular weight from 3 to 4 million g/mole. This is within the

claimed range. The siliceous filler has an average particle size and average surface area within the claimed ranges (column 7, lines 1-5; and column 9, lines 58-60). The microporous material has a thickness of 30 to 400 microns, an average pore size of 0.02 to 0.5 microns and a porosity in the range from 60 to 70% (column 3, lines 35-40; column 10, lines 20-22; and 30-35). It appears that the microporous material meets all the structural limitations and chemistry set forth in the claim. Therefore, it is the examiner's position that the hygroscopic property would be inherently present as like material has like property. This is in line with *In re Spada*, 15 USPQ 2d 1655 (1990) which holds that products of identical chemical composition can not have mutually exclusive properties. The coated article is structurally the same as the multilayer article of the present invention regardless of whether the microporous membrane is commercially available on the market. The polysiloxane solution is applied on the microporous material by spreading (column 14, lines 10-20). Rechlicz does not specifically disclose the polysiloxane coating is obtained by way of a plasma deposition treatment. However, it is a product-by-process limitation not as yet shown to produce a patentably distinct article. It is the examiner's position that the article of Rechlicz is identical to or only slightly different than the claimed article prepared by the method of the claim, because both articles are formed from the same materials, having structural similarity. The coated article comprises a moisture vapor permeable coating of polysiloxane on one side of the sheet of microporous material (abstract). The microporous material is a matrix of polyolefin and

siliceous filler, having interconnecting pores. The polyolefin is formed from a Ultrahigh molecular weight polyethylene (UHMWPE) which is commercially available under the trade name Himont 1900. Zachariades et al. (US 5,479,952) will be relied upon to show the state of fact, that is, the UHMWPE has an average molecular weight from 1 to 8 million g/mole. This is within the claimed range. The siliceous filler has an average particle size and average surface area within the claimed ranges (column 7, lines 1-5; and column 9, lines 58-60). The microporous material has a thickness of 30 to 400 microns, an average pore size of 0.02 to 0.5 microns and a porosity in the range from 60 to 70% (column 3, lines 35-40; column 10, lines 20-22; and 30-35). Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289,291 (Fed. Cir. 1983). It is noted that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with

Rechlicz. Accordingly, Rechlicz anticipates or strongly suggests the claimed subject matter.

8. Claims 53-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rechlicz et al. (US 5,032,450) as applied to claim 39 above, and further in view of Gohlke (US 4,344,999). Rechlicz disclose that at least one layer of microporous thermoplastic material is provided on one surface of the microporous material opposite from the polysiloxane coating (column 15, lines 45-50). Rechlicz does not specifically disclose the at least one layer which is comprised of a hydrophobic polypropylene membrane. Gohlke, however, teaches a breathable laminate for use in hospital gowns comprising an outer layer of a hydrophilic membrane, an intermediate layer of a hydrophobic membrane and an inner layer of a textile fabric (figure 1). The hydrophobic membrane is commercially available under the trade name CELGARD (column 5, lines 35-36). Thus, the hydrophobic membrane is inherently made from an isotactic polypropylene homopolymer as like material has like property. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add a hydrophobic membrane and a layer of the textile fabric to one side of the microporous material of Rechlicz wherein the hydrophobic membrane is sandwiched between the layer of the textile fabric and the microporous material motivated by the desire to provide a hospital gown that is waterproof and bacterial impervious while maintaining the desired moisture vapor transmission.

9. Claims 39, 61-65, and 69 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 2002-336635. JP'635 teaches a sheet-like desiccant comprising a non-woven fabric, and a moisture permeable, water-impermeable film having water-vapor transmission rate of 50 -6000 g/m<sup>2</sup>.24 hours laminated on one surface of the non-woven fabric, and a moisture permeable, water-impermeable film having water-vapor transmission rate of less than 50 g/m<sup>2</sup>.24 hours on the other surface of the non-woven fabric. The non-woven fabric contains high water absorbing fibers and hence hygroscopic. The non-woven fabric reads on the claimed first layer whereas one of the films reads on the claimed second layer. JP'635 does not specifically teach the film having been applied over the fabric material by plasma deposition treatment. However, it is a product-by-process limitation not as yet shown to produce a patentably distinct article. It is the examiner's position that the article of JP '635 is identical to or only slightly different than the claimed article prepared by the method of the claim, because both articles are formed from the same materials, having structural similarity. The sheet-like desiccant comprises a non-woven fabric, and a moisture permeable, water-impermeable film having water-vapor transmission rate of 50-6000 g/m<sup>2</sup>.24 hours laminated on one surface of the non-woven fabric, and a moisture permeable, water-impermeable film having water-vapor transmission rate of less than 50 g/m<sup>2</sup>.24 hours on the other surface of the non-woven fabric. The non-woven fabric contains high water absorbing fibers and hence hygroscopic. Even though

product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289,291 (Fed. Cir. 1983). It is noted that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with JP'635. Accordingly, JP'635 anticipates or strongly suggests the claimed subject matter.

### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (571) 272-1485. The examiner can normally be reached on Monday through Thursday, from 9:00 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on (571) 272-1123. The

fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Hai Vo/  
Primary Examiner, Art Unit 1787